



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,221	09/25/2006	Takashi Sueyoshi	8007-1116	1846
465 7590 06/03/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER LOEWE, ROBERT S	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 06/03/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/594,221

Applicant(s)

SUEYOSHI ET AL.

Examiner

ROBERT LOEWE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments/remarks, filed on 5/24/10, have been fully considered. Regarding the previously relied upon prior art rejection to Young et al. (US 2004/0198924), Applicants argue that the phenyl group content taught by Young et al. falls outside that which is claimed. The Examiner agrees and acknowledges that a person having ordinary skill in the art would not adjust the phenyl group content to amounts required by the instant claims (1 to 25% by weight) as Young et al. teaches much higher phenyl group contents (greater than 50%) and teaches that such phenyl group contents are critical to achieving the objectives of the invention taught therein. Therefore, the rejection to Young et al. has been withdrawn.

Regarding the previously relied upon prior art rejection based on Ikeno et al. (US 2004.0028917), Applicants argue that Ikeno et al. does not explicitly teach Applicants claimed phenyl group content of instant claim 1, as amended. To show that such a limitation would have been obvious to a person having ordinary skill in the art, the prior art rejection based on Ikeno et al. has been modified as described below. Ikeno et al. is still believed to be an appropriate prior art reference which may be used to formulate an obviousness type rejection.

The previously relied upon prior art rejection to Gardner et al. (US 2003/0234458) has been withdrawn for reasons similar to those given for the withdrawal of the previously relied upon prior art rejection to Young et al.

Claim Interpretation

The claim interpretations made in the previous Office action are maintained.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeno et al. (US 2004/0028917) in view of a Gelest technical bulletin, further in view of Filas et al. (US Pat. 5,217,811).

Ikeno et al. teaches curable organopolysiloxane compositions comprising an alkenyl-substituted polysiloxane, an organohydrogenpolysiloxane and an addition catalyst (abstract). The alkenyl-substituted polysiloxane are taught to include branched and cyclic structures (paragraphs 0026 and 0029). The organohydrogenpolysiloxanes are also taught to include branched, cyclic and three dimensional network type structures (paragraphs 0033-0034). The addition cure catalyst is selected from well-known platinum-based catalysts (paragraph 0037). The viscosities of components (A), (B) [and (D), not a claimed ingredient] are taught to fall in the range of instant claim 8 such that it would have been obvious that the final viscosity of the final formulations would, in some instances, fall within the range of instant claim 8. Ikeno et al. further teaches and exemplifies the addition of silica filler, which is a well-known fine metal oxide powder. Last, Ikeno et al. teaches that the alkenyl-functional polysiloxanes include phenyl groups. Regarding the molecular weights of components (A) and (B) of claim 1, it is inherent that the molecular weight of the alkenyl-substituted polysiloxane would fall within the range of instant claim 7 (paragraph 0028). Further, the viscosity of the organohydrogenpolysiloxane is taught to be preferably from 5 to 500 mPa·s, the middle and upper portions of that range would yield molecular weights in excess of 5,000 as required by instant claim 7 as evidenced by a Gelest technical bulletin (top of page 15).

While Ikeno et al. does not explicitly teach that the curable organopolysiloxane compositions have a phenyl group content as required by instant claim 1, such phenyl group content is obvious to a person having ordinary skill in the art when taken with the teachings of Filas et al. Ikeno et al. and Filas et al. are combinable because they are from the same field of endeavor, namely, silicone encapsulating materials. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ a phenyl group content of preferably 10 to 20 mol% (which would satisfy Applicants claimed range of 1 to 25 wt%-see

structure at the top of column 4) as taught by Filas et al. (2:45-50) and would have been motivated to do so since Filas et al. teaches that this range offers crosslinked silicone copolymers which have an index of refraction useful for device applications, which in the case of both Filas et al. and Ikeno et al., is encapsulating materials for devices.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT LOEWE whose telephone number is (571)270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/594,221

Page 5

Art Unit: 1796

/RANDY GULAKOWSKI/

Supervisory Patent Examiner, Art Unit 1796